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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/707,713 | 11/07/2000 | Andreas Baltes | 4416 US | 9815 |

7590 01/15/2003

Martin A Farber
866 United Nations Plaza Suite 473
New York, NY 10017

EXAMINER

ALLEN, STEPHONE B

| ART UNIT | PAPER NUMBER |
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2878

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/707,713

Applicant(s)

BALTES, ANDREAS

Examiner

Stephone B. Allen

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the transmitter being arranged on the carrier (claim 5), and the optical signal being deviated onto the diaphragm by a light guide (claim 5); and wherein the light guide covers an extended area to ensure uniform distribution of the optical signal over the diaphragms (claims 9 and 11) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the beam path" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the second of said diaphragms" in line 2. There is insufficient antecedent basis for this limitation in the claim, since a "first" has not been claimed.

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Claim 9 recites the limitation "the diaphragms" in line 4. There is insufficient antecedent basis for this limitation in the claim, since only "a diaphragm" has claimed in claims from which claim 9 depends; further, it is unclear how the light guide "covers an extended area to ensure uniform distribution of the optical signal over the diaphragm". Since the scope of this claim is so unclear, this limitation will not be further treated on the merits.

Claim 11 recites the limitation "the second of said diaphragms" in lines 4-5 . There is insufficient antecedent basis for this limitation in the claim, since a " first" has not been claimed.

Those claims not specifically mentioned are indefinite due to their dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 is rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 5,962,841 to Okumura et al. (Okumura).

Okumura discloses a device for detecting the position of a selector lever 47, in which the selector lever is connected to a device that emits a signal to an evaluation device in a desired position of the lever, wherein the lever is connected to a diaphragm

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Xd, Xe, Xf arranged in a beam path between and optical transmitter and receiver (photo-interrupter 192), the diaphragm follows movement of the lever^{and} is optically transparent Xf in the desired position of the lever as a result of which the receiver receives the signal from the transmitter and transmits it^{to} the evaluation device (Cols. 15-16; Figs. 4-8).

Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,132,531 to Duncan et al. (Duncan).

Duncan discloses a device for detecting the position of a selector lever 34 in which the selector lever is connected to a device that emits a signal to an evaluation device in a desired position of the lever, wherein the lever is connected to a diaphragm10c arranged in a beam path between and optical transmitter and receiver, the diaphragm follows movement of the lever^{and} is optically transparent in the desired position of the lever as a result of which the receiver receives the signal from the transmitter and transmits it the evaluation device (Cols. 2-3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okumura et al. (Okumura).

With direction to claim 2, Okumura fails to disclose wherein there is a said receiver for each position of the lever. However, the inclusion of this feature would have been an obvious design modification for one of ordinary skill in the art make in order to enhance the accuracy of the detection of the position of the lever.

With direction to claim 3, it is inherent that the receiver is fixed on some type of support or carrier and not suspended in space.

With direction to claim 4, Okumura is silent as to the disposition of the evaluation device, however, the location of the device would have been an obvious design modification for one of ordinary skill in the art to make, in order to obtain a more compact system.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okumura et al. (Okumura) in view of U.S. Patent No. 4,223,217 to Bongard et al. (Bongard).

Okumura is silent as to the disposition of the optical transmitter, however, the location of the device would have been an obvious design modification for one of ordinary skill in the art to make, in order to obtain a more compact system. Further, Okumura fails to disclose the use of a light guide to deviate the path of the optical signal from the transmitter onto the diaphragm. Bongard, in Figure 10, discloses the use of a light guide to as a means of directed light from one location to another, it would have been an obvious design modification for one of ordinary skill in the art to modify the

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system of Okumura to include such a feature in order to provide remote access to the diaphragm, if so desired.

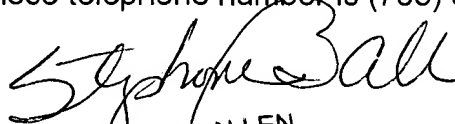
Allowable Subject Matter

Claims 6-8, 10 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephone B. Allen whose telephone number is (703) 308-4828. The examiner can normally be reached on Monday-Thursday from 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Porta can be reached on (703) 308-4852. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


STEPHONE ALLEN
PRIMARY EXAMINER

sba
January 13, 2003